

REMARKS

Responsive to the Office Action mailed on February 24, 2006 in the above-referenced application, Applicant respectfully argues as follows.

Present Status of Application

Claims 1-3, 6, 10, 12, 15, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hobson et al (US 6,199,979).

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Hirose et al (US 6,120,140).

Claims 2, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobson et al (US 6,199,979) in view of Kitahara et al (US 6,190,009).

Claims 4, 5, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobson et al (US 6,199,979) in view of Engel et al (US 6,926,957).

Claims 7, 8, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobson et al (US 6,199,979) in view of Hayashi et al (US 2001/0035897).

Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobson et al (US 6,199,979) as modified by Hayashi et al (US 2001/0035897) as applied to claim 1 above, and further in view of Reem et al (US 2004/0094065).

Claims 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al (US 6,120,140) in view of Engel et al (US 6,926,957).

Insufficient rejections

Applicant submits that the rejections in the office action are insufficient, insofar as they do not comply with the requirements of MPEP 707.07 et seq., which require that all rejections be stated with completeness and clarity. More specifically, MPEP 707.07(d) requires that the grounds for rejection for rejection be "fully and clearly stated.". The Office Action has failed to do this in the present application.

For example, at page 2 of the office action, the examiner asserts that:

"Claims 1-3, 6, 10, 12, 15, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hobson et al (US 6,199,979).

"Honson et al discloses:

*-regarding claim 1, method for filling an ink into an ink cartridge, comprising: treating a filter with a surfactant to increase the hydrophilicity of the filter, wherein the filter has pores **(Column 8, lines 1-10)***

*-installing the treated filter in an ink cartridge; and
filling an ink into the ink cartridge to pass through the treated filter
(Column 3, lines 14-24)."*

Turning to the second portion of Hobson cited by the Examiner (Column 3, lines 14-24), Honson discloses:

"The present invention provides an improved ink filter for removing contaminants and/or agglomerates from ink within an ink printer cartridge. The present invention utilizes the unique properties of a microporous membrane as the filter medium. In a preferred embodiment of the present invention, the filter material comprises a microporous membrane of expanded polytetrafluoroethylene (PTFE), sintered granular PTFE, polyolefin, ultrahigh molecular weight, polyethylene, and the like. In addition, in another

embodiment of the present invention, the microporous membrane of the present invention can be laminated to a variety of backing materials."

The rejection is not clear, such that applicant cannot find "installing the treated filter in an ink cartridge" as recited in claim 1 in this paragraph. Further, "filling an ink into the ink cartridge to pass through the treated filter" cited in claim 1 is also not found in this paragraph.

Please fully and clearly point out where does Honson disclose "installing the treated filter in an ink cartridge" as recited in claim 1.

Additionally, please also fully and clearly point out where does Honson disclose "filling an ink into the ink cartridge to pass through the treated filter" as also recited in claim 1.

The rejection of claim 10 is also not clearly stated. So the Applicant also requests the Examiner to point out fully and clearly where does Honson disclose "filling an ink into the ink cartridge to pass through the treated filter" as also recited in claim 10.

For another example of an unclear rejection, at page 3 of the office action, the Examiner asserts that:

"Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Hirosawa et al (US 6,120,140).

"Hirosawa et al discloses:

-regarding claim 19, method for filling an ink into an ink cartridge, comprising:providing an ink cartridge having an ink passage, wherein the ink passage has a wall (Column 11, lines 28-45) treating the wall of the ink passage with a surfactant to increase the hydrophilicity of the wall of the ink passage (Column 11, lines 28-45);

filling an ink into the ink cartridge to pass through the treated the ink passage (Column 8, lines 1-7)."

Turning to the first portion of Hirosawa cited by the Examiner (Column 11, lines 28-45), Hirosawa discloses:

"It is also discovered that when the foreign matters removing apparatus is structured like this embodiment in which the filter 46 is disposed so as to extend in the direction of the slanted flow passage 47b, it is possible to make it more difficult for the microscopic bubbles to cling to the filter 46, and also, it becomes easier to remove them from the flow passage. As for the microscopic bubbles mentioned above, it is more liable for them to develop when surfactant is mixed into the ink as means for obtaining picture quality of a higher degree. Since the cross sections of these microscopic bubbles are extremely small, the ink pressure does not satisfactorily affect them; in other words, it is rather difficult to force them through the filtering portion. In particular, when the bubbles with an approximately the same size as the mesh size of the filter adhere to the filter, they tend to remain there in stable condition due to the surface tension or the like; therefore, it is difficult to remove them, reducing consequently the effective area of the filter.

Where does Hirosawa disclose "providing an ink cartridge having an ink passage, wherein the ink passage has a wall" as recited by claim 19?

Where does Hirosawa disclose "treating the wall of the ink passage with a surfactant to increase the hydrophilicity of the wall of the ink passage" as recited by claim 19?

At Column 8, lines 1-7 of, Hirosawa discloses:

"and ink storing portion, which are mounted on the carriage, is given in FIG. 8. In FIG. 8, a reference numeral 41 designates an ink cartridge as the ink storing portion, and a reference numeral 48 designates a carriage on which the ink cartridge 41 and a recording head cartridge 42 as the recording means, which will be described later, are removably mounted."

Applicant also cannot find "filling an ink into the ink cartridge to pass through the treated the ink passage" as recited by claim 19 in this passage.

New claims 22 -25 are added by the response to recite that "the step of filling ink into the ink cartridge includes passing ink through the treated filter as the ink cartridge fills with ink" to make this point even more explicit should the Examiner have overlooked the relevant language in the independent claims.

The rejections fail to completely and sufficiently address the subject matter of the claims. For this reason alone, the rejections of claims 1-21 should be withdrawn. Should an ensuing Office Action be mailed, which provides more detail in this regard, Applicant submits that any such ensuing Official Action should be made in non-final.

The examples described are only parts in the office action, which are not clear. There are still many unclear assertions in the office action. Applicant strongly requests the Examiner ensure that any future the rejections are "fully and clearly stated" as required by MPEP.

Withdrawal of the rejections and allowance of the claims are respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

Response to Official Action

Dated 24 February 2006

Re: USSN 10/783,475

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necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

June 23, 2006

(Date of Deposit)

Esther M. Hayes

(Name of Person Depositing)

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Respectfully submitted,



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